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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,355	12/12/2001	Michael D. Hooven	HOOV 113	1021
26568	7590	09/29/2004	EXAMINER	
COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER LTD SUITE 2850 200 WEST ADAMS STREET CHICAGO, IL 60606			ROLLINS, ROSILAND STACIE	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,355

Applicant(s)

HOOVEN, MICHAEL D.

Examiner

Rosiland S Rollins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 9, 14, 15 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmaltz et al. (US 6050996). Schmaltz et al. discloses a device for clamping and ablating tissue comprising a first and second handle member, first and second jaw members, first and second elongated conductive ablation members (11, 12), elongate support members (22, 23) supporting substantially the entire length of its associated conductive member and an insulator (24) disposed between the conductive member and the support member.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4, 8, 10, 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmaltz et al. Schmaltz et al. teaches all of the limitations of the claims except the specific dimensions of the ablation member as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made

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to select the claimed dimensions for the ablation member since it has been held to be within the skill level of a worker in the art to choose the dimensions of an instrument on the basis of its suitability for the intended use as a matter of obvious design choice.

Claims 5, 7, 11, 13, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmaltz et al. further in view of Yamauchi (US 6273887). Schmaltz et al. teaches all of the limitations of the claims except the conductive member being a wire. Yamauchi disclose a similar device and teach that it is old and well known in the art to provide a wire electrode to decrease the contact area between the electrode and tissue. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a wire as the conductive member of Schmaltz et al. to limit the contact area between the electrode and tissue and focus the energy being supplied to the tissue.

Claims 6 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmaltz et al. further in view of Baker (US 6113598). Schmaltz et al. teach all of the limitations of the claims except the conductive ablation members defining an interior bore. Baker it all teach that it is old and well known in the art to provide conductive ablation members with an interior bore (figures 11-14) to assist in the reduction of charring. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include an interior bore in the conductive ablation members of Schmaltz et al. particularly in view of the teaching of Baker.

Double Patenting

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6517536 in view of Schmaltz et al. The patent claims teach all of the limitations of the application claims except the jaw comprising an insulator between the conductive member and support member. Schmaltz et al. discloses that it is old and well known in the art to provide an insulator between the conductive member and support member to avoid short-circuiting. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an insulator between the conductive member and support member to avoid short circuiting the instrument.

Response to Arguments

Applicant's arguments filed August 20, 2004 have been fully considered but they are not persuasive. Applicant argues that the clamping surface of Schmaltz is comprised entirely of the electrically conductive seal surface and that no other portion of the jaw is a part of the clamping surface. To support this argument applicant refers to

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figures 2, 3, 8 and 10. Examiner maintains that the entire surface of the Schmaltz jaw contributes to clamping tissue there between especially in the case where the tissue being treated is relatively thick and would inherently touch the insulating portions of the jaw structure once the conductive projections were applied to the tissue.

Applicant argues that the MPEP does not describe an instance of double patenting where the grounds for rejection are based on an issued patent filed by the same inventive entity and another patent not owned by the same inventive entity. Applicant's attention is directed to MPEP section 804 II. B. 1. where obviousness-type double patenting is discussed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosiland S Rollins whose telephone number is 703/3082711. The examiner can normally be reached on Mon.-Fri. 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 703/3080994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Rosiland S Rollins
Primary Examiner
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